

## **REMARKS**

Claims 2-6 and 8-11 are pending in the application with claims 2, 5, and 9 being the independent claims. Claims 2, 3, and 5 are amended. Claims 1 and 7 are canceled without prejudice to or disclaimer of the subject matter therein. Claims 8-11 are new. Support for the amendments and new claims can be found in the specification, drawings, and originally filed claims.

### **Rejection under 35 U.S.C. § 102**

Claims 1, 3, 5, and 7 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,408,743 to Tournier et al. Applicants have canceled claims 1 and 7, and amended claim 3 to depend from claim 2.

Claim 5 is directed to a method of mounting a terminal to a covered electric wire. The method includes removing a front end of a covering on the covered electric wire to expose a leading end of an electric conductor. The leading end of the electric conductor and a part of the covering are received in a cylindrical wire end receiving portion of the terminal. The cylindrical wire end receiving portion is uniformly compressed around the entire circumference in a radial direction so that the cylindrical wire end receiving portion and at least a portion of the leading end of the electric conductor plastically deform, and so that a plurality of annular projections on an inner surface of the wire end receiving portion contact the part of the covering of the covered electric wire. Claim 5 is amended to include the subject matter of claim 2, namely a plurality of projections. In addition, claim 5 recites that the projections are annular.

Tournier discloses a connecting part (10) having a hollowed out portion (10a) formed of a blind hole (20). An electric cable (12) is received in the blind hole (20), and

the connecting part (10) is fed into a die to reduce the diameter of the hollowed out portion (10a) around the electric cable (12).

Claim 5 is not anticipated by Tournier et al. because Tournier does not disclose a method of mounting a terminal to a covered electric wire that includes all the features of claim 5, including “uniformly compressing the cylindrical wire end receiving portion . . . so that a plurality of annular projections on an inner surface of the wire end receiving portion contact the part of the covering of the covered electric wire.” Instead, the connecting part (10) disclosed in Tournier has smooth, cylindrical inner walls separated only by a shoulder surface (27). And a shoulder is not a plurality of annular projections. Accordingly, Tournier cannot anticipate any claim reciting a method including compressing an end portion so that a plurality of annular projections on an inner surface of the wire end receiving portion contact a part of a covering on a covered electric wire. Therefore, claim 5 is not anticipated by Tournier.

### **Rejection under 35 U.S.C. § 103**

#### **Claims 2 and 4**

Claims 2 and 4 stand rejected under 35 U.S.C. § 102 as being unpatentable over Tournier in view of U.S. Patent No. 3,042,737 to Brumbach et al. Claim 2 is rewritten in independent form to include all the features of its base claim. Claim 2 is directed to a structure for mounting a terminal to a covered electric wire. The structure includes a terminal comprising a cylindrical wire end receiving portion and a cylindrical connecting portion for connecting to other equipment. An inner surface of the wire end receiving portion comprises a plurality of projections. The structure also includes a covered electric wire from which a leading end of a covering is removed to expose a leading

end of an electric conductor. The wire end receiving portion receives the leading end of the exposed electric conductor of the covered electric wire and a part of the covering. Additionally, the wire end receiving portion is uniformly compressed around substantially the entire periphery thereof to be in close contact with the exposed electric conductor.

Brumbach discloses a hose coupling system including a ferrule or collar element (26) that is internally threaded as at (26a) for a gripping arrangement with the receiving end of a piece of tubing. Brumbach, column 2, line 72-column 3, line 3. In use, the ferrule member (26) is threaded onto the respective end of the tubing to grip the material of an outer sheath of the tubing. Brumbach, column 3, lines 33-35.

However, the combination of Tournier and Brumbach does not establish a *prima facie* case of obviousness rendering claim 2 unpatentable because there is no motivation in the art itself to combine the references in the manner disclosed. The Office Action states that the motivation to combine would be to provide gripping arrangement with the covered wire. However, one skilled in the art would not be motivated to combine Tournier and Brumbach for such a purpose without the benefit of the teachings of the present application. Tournier discloses that a wire may be connected through crimping or swaging of a flared connecting part to squeeze the wire in place. Brumbach discloses a ferrule with threads allowing it to be threaded onto the end of a hose. One would not combine the crimping method with the threaded method because the threads taught by Brumbach would be on the inner surface of the flare of Tournier, and the flared threads would not engage or secure a hose or wire threaded into the ferrule until the ferrule is crimped or swaged. Because of this, the threads would not be able to serve a threading purpose. Therefore, using only the teachings in

the art, one would not be motivated to include the threads taught by Brumbach with the connecting part taught by Tournier. Accordingly, claim 2 is allowable over the combination of references. Applicants respectfully request that the Examiner withdraw the rejection and allow these claims.

Claims 3, 4, and new claim 8 depend from and add additional features to independent claim 2. Accordingly, these claims are allowable for the reasons set forth above.

### **New Claims 9-11**

Claim 9 recites all the features of claim 2, with the additional feature that the plurality of projections are annular projections. Claim 9 is not obvious because there is no motivation to combine Tournier and Brumbach. Additionally, claim 9 is not obvious because the combination of Tournier and Brumbach do not teach or suggest all the claim limitations. For example neither Tournier nor Brumbach teaches or suggests a plurality of projections with annular projections.

Brumbach is relied on for the teaching of projections. But Brumbach discloses only spiral threads in a ferrule that allow the ferrule to be threaded onto a hose. A spiral thread is not a plurality of annular projections. Instead, it is a spiral extending axially along the ferrule. Likewise, Tournier does not teach a plurality of projections. Accordingly, claims 5 and 8 are not rendered obvious in view the combination of Tournier and Brumbach.

Claims 10 and 11 depend from and add additional features to independent claim 9. Accordingly, these claims are allowable for the reasons set forth above.

## Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Dustin T. Johnson  
Reg. No. 47,684

Dated: March 9, 2004